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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,344	12/22/1999	DANIEL I. KERPELMAN	GEMS;0065/	6033

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EXAMINER

MORGAN, ROBERT W

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/470,344

Applicant(s)

KERPELMAN ET AL.

Examiner

Robert W. Morgan

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed ^{response} amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1-60.Claim(s) withdrawn from consideration: NONE.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


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Continuation of 5. does NOT place the application in condition for allowance because: Applicants After Final Amendment has been considered but fails to overcome the cited references and the finality of the previous Office Action is maintained. Note response to Attorney's argument attached herewith.

Advisory Action

In the remark, Applicant argues in substance that (1) the Examiner provides support under M.P.E.P. § 2144.03 for the assertion of what is “well known in the art” regarding the data communication control system and a remote service provider; (2) the combination of the Wong et al. and Microsoft Computer Dictionary terms are inconsistent with the reference and does not provide the missing element; (3) Wong et al. does not teach “the client including a medical diagnostic imaging system”; and (4) Wong et al. fails to teach “data indicative of a location of the mobile client”.

In response to Applicants argument that, (1) the Examiner provides support under M.P.E.P. § 2144.03 for the assertion of what is “well known in the art” regarding the data communication control system and a remote service provider and (2) the combination of the Wong et al. and Microsoft Computer Dictionary terms are inconsistent with the reference and does not provide the missing element. The Examiner respectfully submits that Wong et al. teaches a medical image distributing system that uses a medical image server (12, Fig. 1) and a plurality of network-attached client workstations for receiving and transferring medical images (see: column 3, lines 61 to column 4, lines 15). Additionally, Wong et al. teaches the use of links (36, Fig. 1) implemented with the TCP/IP suite of protocols that could be campus intranet, a wide-area intranet or even the Internet. The operation of the Internet includes dialing up an Internet service provider (remote service provider) via modem with a router (data communication control system) that connects the network using the same communication protocols to pass information to and from each other. The definitions of a Domain Name System

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(DNS), Domain Name System (DNS) server and remote access service in the previous Office Action are all components of using the Internet.

In addition, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features.

Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

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As such, it is respectfully submitted that Applicant appears to view the applied reference in a vacuum without considering the knowledge of average skill in the art.


In this particular case, one having ordinary skill in the art of network-based medical distribution system (such as Wong et al.) is presumed to know of general network components and techniques (i.e., communication control elements and DNS, DNS server, and RAS), as well.

In response to Applicants argument that, (3) Wong et al. does not teach “the client including a medical diagnostic imaging system”. The Examiner respectfully submits that Wong et al. teaches a medical image distributing system that uses a medical image server (12, Fig. 1) and a plurality of network-attached client workstation for receiving and transferring medical images (see: column 3, lines 61 to column 4, lines 15). Additionally, the network-attached client workstations are configured with object-oriented graphical interface for receiving medical image requests for a user and in order for the medical image request to be initiated by a user, the request data, which is considered “client data” is transmitted from the client workstation (see: column 3, lines 60 to column 4, lines 15). This is a clear indication that the client workstations receives medical image requests and digital medical images such as MRI, ultrasound, CT, X-ray etc... and as a result demonstrates that the client workstations could be considered medical diagnostic imaging systems.

In response to Applicants argument that, (4) Wong et al. fails to teach “ data indicative of a location of the mobile client”. The Examiner respectfully submits that it was the Wong et al. reference, in light of the knowledge of well-known concepts of the prior art that was relied upon for the specific teaching of the IP address and the location of computer. Wong et al. in combination with what is well known in art, such as the definitions of a Domain Name System

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(DNS) and Domain Name System (DNS) server of the previous Office Action clearly indicate that domain name and IP addresses are included with receipt and transfer of information over the Internet. In addition, other prior art such as Evans as discussed in the prior Office Action, clearly discloses the use of laptop computer to access local area networks (LAN) and wide area networks (see: column 12, line 55 to column 13, lines 15 and Fig. 24). Thus, the knowledge and use of laptop or physically mobile clients over a network, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).



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